

REMARKS

Applicants request reconsideration of the present application in light of the preceding amendments and the following remarks.

IDS

Because the USPTO is missing copies of previously submitted references, applicants will file a second IDS with copies of the references that were not considered in the IDS filed on February 24, 2005.

Drawings

Applicants have responded to the objection to the drawings by canceling Figures 1 and 2, sheets 1-41. These figures are not necessary to understand the presently claimed invention.

Rejections Under 35 USC 112

The claims have been amended to overcome the outstanding rejections for indefiniteness.

Obviousness-Type Double Patenting Rejections

Applicants request that the Examiner withdraw the provisional judicially created obviousness-type double patenting rejection over Application No. 10/458,730. With the submission of this response, applicants believe that all outstanding rejections have been overcome. MPEP § 804 I. B., reproduced below, states that when a provisional obviousness-type double patenting rejection is the only rejection remaining, the Examiner should withdraw the rejection and allow the application to issue as a patent.

The "provisional" double patenting rejection should continue to be made by the examiner in each application as long as there are conflicting claims in more than one application unless that "provisional" double patenting rejection is the only rejection remaining in one of the applications. If the "provisional" double patenting rejection in one application is the only rejection remaining in that application, the examiner should then withdraw that rejection and permit the application to issue as a patent, thereby converting the "provisional" double

patenting rejection in the other application(s) into a double patenting rejection at the time the one application issues as a patent.

If the "provisional" double patenting rejections in both applications are the only rejections remaining in those applications, the examiner should then withdraw that rejection in one of the applications (e.g., the application with the earlier filing date) and permit the application to issue as a patent. The examiner should maintain the double patenting rejection in the other application as a "provisional" double patenting rejection which will be converted into a double patenting rejection when the one application issues as a patent.

Applicants respond to the rejections for obviousness type double patenting as follows. In making the contention of obviousness against the cited patents (US Patent Nos. 5,792,783, 6,906,093, 6,531,502 and 6,486,185), the Examiner has not proffered any analysis of how the cited patents teach or suggest the recitations of the presently elected species and claims. Merely indicating a listing of claim numbers and making the conclusory statement that this claims render an invention obvious does not provide the level of analysis needed to establish a *prima facie* case of obviousness. Therefore, applicants contend, the Examiner has not met the burden of establishing a *prima facie* case of obviousness.

US Patent No. 6,906,093 is further distinguishable from the elected species because the sole independent claim requires an unsubstituted alkyl at the 3 position of the pyrrole whereas the presently elected species is a bromo at the 3 position of the pyrrole.

US Patent No. 6,531,502 is further distinguishable from the elected species because in independent claim 1 R¹¹ is not bromo or halo but hydrogen, alkyl or -C(O)OR¹⁹ and R¹¹ is not bromo or halo but a substituted alkyl group. Independent claims 14 and 15 are not to a compound that is suggestive of the dibromo substituents of the present claims. Instead of the dibromo substituents of the present elected species, the compound of claims 14 and 15 has a propionic acid and a hydrogen.

Rejections Under 35 USC 103*US Patent No. 5,792,783*

As explained below, US Patent No. 5,792,783 does not qualify as prior art because the '783 patent issued on August 11, 1998, which is after the August 20, 1997 earliest priority date of the present application, is eligible for the safe harbor provision of 35 USC § 103(c), which is reproduced below.

(c) Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person. (Emphasis added).

MPEP §§ 706(l)(1)-(3) discuss in detail how Examiners are to handle the safe harbor provision of this section.

Therefore, in accordance with 35 USC 103(c) and MPEP §§ 706(l)(1)-(3), the undersigned attorney of record states that, the present application and US Patent No. 5,792,783 were, at the time the invention of the present application was made, owned by Sugent Inc. In accordance with MPEP § 706.02(l)(2), this statement is sufficient to disqualify US Patent No. 5,792,783 from being used as prior art in a rejection for obviousness against the present claims.

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In order to establish a *prima facie* case of obviousness, the burden is upon the Examiner to demonstrate the following three elements: (1) motivation to combine or modify references, (2) a reasonable expectation of success and (3) a teaching or suggestion of all the elements of the claims. If applicants can demonstrate that at least one of these elements has not been met, a *prima facie* case of obviousness has not been established and the rejection is improper. MPEP § 706.02(j).

Applicants contend that the disclosure of WO '116 does not render the invention obvious. Applicants urge that one cannot base a finding of obviousness on what the skilled

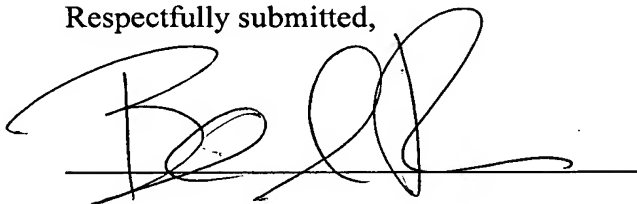
artisan might try or find obvious to try, but the proper analysis is determining what the prior art would have led the skilled artisan to do. The Federal Circuit has held that “an ‘obvious to experiment’ standard for obviousness” is incorrect. *In re Dow Chemical Co. v. American Cyanamid Co.*, 5 USPQ2D 1530, 1532 (Fed. Cir. 1988). Also, the prior art must provide a reason or suggestion for selecting the claimed combination. Applicants urge that a proper obviousness analysis, without the hindsight of the present specification, does not lead to a conclusion of obviousness. The Examiner is therefore urged to reconsider the rejections under 35 USC §103, in light of the following words on obviousness from a recent opinion from the Federal Circuit. “Our case law makes it clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references.” *In re Dembiczak*, 50 USPQ2d 1614 (Fed. Cir. 1999).

Applicants understand the Examiner’s rejection for obviousness is based on the disclosure of WO ‘116 of Formula III, pages 16-17, particularly the compound at page 17, lines 25-26. (The office action states “especially the compound on page 16, lines 23-24.” Applicants understand this to be an error because the compound disclosed at these pages is benzylidenyl indolinone of Formula II, not a pyrrole indolinone of Formula III.)

The compound at page 17, lines 25-26 is a 3-[(2,3-dimethylpyrrol-5-yl)methylene-2-indolinone. This compound has (A) an indolinone ring that is unsubstituted, and (B) a pyrrole ring that is disubstituted in the 2 and 3 positions with methyl. In contrast the presently elected species has (A) a indolinone ring, substituted at the 4 position with an amino group and (B) a pyrrole ring that is trisubstituent with a bromo at the 3 and 4 positions and methyl at the 2 position. The Examiner has failed to establish why out of the numerous available substitutions, one of skill in the art would have been motivated to arrive at the presently elected species.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Beth A. Burrous', written over a horizontal line.

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